REMARKS

The first full paragraph on page 26 teaches a buffer of interest. Accordingly, no issue of new matter arises, and entry of the amendments is requested respectfully.

I. At the top of page 2 of the Office Action, the Examiner raised an issue with respect to sequence identifiers.

Sequence identifiers are introduced in some of the amendments above and in the Replacement Sheets of certain sheets of drawings filed concurrently herewith. No new matter was introduced into the specification by addition of the sequence identifiers in the text and drawings.

II. Beginning at the bottom of page 2 of the Office Action, the Examiner discussed the elections.

Regarding the issue as to SEQ ID NO:8, applicants stated in the previous reply, the sequences have a common property of binding ghrelin. Moreover, the molecules must share a common structure to be able to bind the same one molecule. The nucleic acids of interest do not hybridize in the classical sense of single strands of nucleic acids hybridizing to form a duplex molecule. Instead the nucleic acids of interest are more analogous to antibodies where, as known, the antibody-antigen reaction is based, in part, on conformation to enable the antibody to recognize and to bind to the cognate antigen, as do a lock and key. Thus, while the actual nucleic acid sequence of a pair of spiegelmers may vary, that variation is of no moment if both molecules bind to the cognate target molecule, as do the plurality of spiegelmers disclosed in the instant application which bind ghrelin. Finally, please note that SEQ ID NO:8 is the same as SEQ ID NO:37.

III. On page 4 of the Office Action, the Examiner objected to the Declaration because changes were made thereto without an author acknowledging the change.

A new executed Declaration is filed concurrently herewith.

IV. At the middle of page 4 of the Office Action, the Examiner raised in informality with the text, reference to a claim was mentioned.

The text of the specification has been amended.

V. Regarding the Information Disclosure Statement, as noted in the paragraph bridging pages 4 and 5 of the Office Action, the German language reference was not considered because a full English language translation or a concise statement of relevance was not provided.

Another Information Disclosure Statement is filed concurrently herewith regarding the same reference but including a concise statement of materiality.

DE 198 08 591 relates to a whole blood assay using a flow cytometer. The particular assay is a competition assay using a fluorogenic substrate and potentially therapeutic fibrinogen receptor antagonists competing for binding to the fibrinogen receptor. The effect was observed on thrombocytes. Some of the antagonists could be aptamers. However, as noted, those would be directed to binding the fibrinogen receptor.

Consideration of the reference is requested respectfully.

VI. On pages 6 and 7 of the Office Action, the Examiner issued two judicially-created obviousness-type double patenting rejections.

The rejections are traversed for the following reasons.

The subject matter of the instant claims is not suggested or rendered obvious with a reasonable expectation of success by CLAIMS 1, 2, 4-10 and 12 of the '938 application or by CLAIMS 1-39, 43-45, 49-51 and 56 of the '459 application.

Accordingly, a prima facie case of obviousness has not been made and the two provisional rejections can be removed.

VII. At the lower half of page 7, the Examiner raised an objection to claims 12, 13 and 31-36 as not limiting the subject matter of a previous claim. The Examiner provided an explanation based on the varying Kd subject to incubation conditions.

The objection is traversed for the following reasons.

To provide a framework for a binding constant determination, applicants recite now in the relevant claims, a buffer used for determining the binding constants of interest. Hence, the objection can be removed.

VIII. Halfway down page 8 of the Office Action, claims 1, 2, 26 and 30 were rejected under 35 U.S.C. 103(a) over Bryant et al. in view of Gold et al.

According to the Examiner, Bryant et al. relates to controlling food intake by manipulating ghrelin metabolism. Thus, a neutralizing agent such as an antibody that binds ghrelin is taught as means for inhibiting ghrelin action, and thus, obesity.

The rejection is traversed for the following reasons.

Contrary to the position of the Examiner, there is no reasonable predictability of successfully obtaining a spiegelmer, particularly if the target is basic, as is ghrelin, see paragraph bridging pages 7 and 8 of the instant application, where there is a high degree of non-specific binding, and hence, considerable background (see for example, Eaton et al., Bioorg Med Chem 5:1087-1096, 1997, copy attached hereto for the convenience of the Examiner, and which is cited in the instant specification, page 1088, left column, first full paragraph).

Hence, there is no predictability, there is no reasonable expectation of obtaining a spiegelmer to ghrelin and thus, a prima facie case of obviousness has not been made.

Accordingly, the rejection must be removed.

IX. On page 10 of the Office Action, claims 1-4, 6, 26 and 30 were rejected under 35 U.S.C. 103(a) over Bryant et al. and Gold et al., and further in view of two Noxxon publications.

Essentially, the Examiner took the position that in light of the Noxxon publications describing use of their technology, in general, it would have been obvious to obtain a spiegelmer to ghrelin.

The rejection is traversed for the following reasons.

Contrary to the position of the Examiner, there is no reasonable prediction of successfully obtaining a spiegelmer, particularly if the target is basic, as is ghrelin, where there is a high

degree of non-specific binding, and hence, considerable background, see for example, Eaton et al., supra. Hence, there is no predictability, there is no reasonable expectation of obtaining a spiegelmer to ghrelin and thus, a prima facie case of obviousness has not been made.

Accordingly, the rejection must be removed.

X. The Examiner affirmed the patentability of claims 8-11, 14, 27, 37-41 and 45-49 as to SEQ ID NO:8 (also SEQ ID NO:37).

CONCLUSION

Applicants have taken steps to place the instant application in condition for allowance. Reexamination, reconsideration, withdrawal of the objections and rejections, and early indication of allowance are solicited earnestly.

Respectfully submitted,

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